

REMARKS/ARGUMENTS

In the Office Action mailed March 1, 2007, the Office Action rejected claims 21-29 under 35 U.S.C. § 101. The Office Action also rejected claims 1-29 under 35 U.S.C. § 102. Claims 1, 12 and 21-29 have been amended.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

I. Claims 21-29 Rejected Under 35 U.S.C. § 101

The Office Action rejected claims 21-29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 21 has been amended, as per the suggestion provided by the Office Action, to recite “a computer-readable medium configured to store a set of instructions.” Support for this amendment may be found in Applicants’ specification, for example, page 5, lines 9-13. Claims 22-29 has been amended to also recite “computer-readable medium” as suggested by the Office Action. As such, Applicants submit that claims 21-29 are directed to statutory subject matter. Accordingly, Applicants respectfully request that the rejection of claims 21-29 be withdrawn.

II. Claims 1-29 Rejected Under 35 U.S.C. § 102

The Office Action rejected claims 1-29 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,142,318 to Lopez et al. (hereinafter, “Lopez”). This rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ... claim.” Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, “the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that the claims at issue are patentably distinct from Lopez. Lopez does not disclose all of the limitations in these claims.

Claim 1 has been amended to recite “scanning a plurality of pages using a scanner adapted for printing to produce a scan job.” Support for this amendment may be found in Applicants’ specification, for example, page 3, lines 7-9 and page 8, line 23 – page 9, line 6. Lopez does not disclose this claim element.

For example, Lopez states:

The printing system preferably includes subsystems which obtain certain image files associated with a specified web page, print a proof sheet associated with those images, allow the user to select which of the images are to be printed, and print these user-selected image files.

Lopez, col. 3, lines 44-49.

The Office Action points to this passage of Lopez to support the assertion that Lopez discloses a “proof sheet containing a selected sub-set of the information contained within the scan job.” See Office Action, pages 3-4. Lopez also states:

When the image files 2 have been retrieved, the proof sheet analyzer 82 sends them to an image printing subsystem 84 along with the printing instructions marked by the user in the user-designation area 54 for each image file.

Lopez, col. 5, lines 24-27.

The Office Action points to this portion of Lopez to support the assertion that Lopez discloses “where the result of electing is to accept the scan job, sending the scan job.” Thus, it appears that the Office Action is equating “image files” with the “scan job.” However, Lopez does not disclose that these “image files” are scanned “using a scanner adapted for printing.”

Instead, Lopez discloses “the image files associated with the marked selection areas are printed.” Lopez, col. 2, line 39. Printing the image files does not disclose “scanning a plurality of pages using a scanner adapted for printing to produce a scan job.” In fact, Lopez only discloses that “[t]he marked proof sheet is scanned so as to determine marked selection areas.” Lopez, col. 2, lines 37-38. The marked proof sheet does not disclose the “scan job” because claim 1 recites that the “proof sheet contain[s] a selected sub-set of the information contained within the scan job.” In other

words, if the marked proof sheet of Lopez were the “scan job”, the marked proof sheet would have to “contain[] a selected sub-set of the information” of the marked proof sheet. Instead, as previously stated, the proof sheet of Lopez contains “certain image files associated with a specified web page.” Lopez, col. 3, lines 46-47.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Lopez. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 2-11 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-11 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claim 12 has been amended to recite “where a plurality of pages have been scanned using said scanner to produce a scan job.” Support for this amendment may be found in Applicants’ specification, for example, page 3, lines 7-9 and page 8, line 23 – page 9, line 6. As previously explained in connection with claim 1, Lopez does not disclose scanning “a plurality of pages . . . using said scanner to produce a scan job.” As such, Applicants submit that claim 12 is patentably distinct from Lopez for at least the same reasons as those presented above in connection with claim 1. Accordingly, Applicants respectfully request that the rejection of claim 12 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claims 13-20 depend either directly or indirectly from claim 12. Accordingly, Applicants respectfully request that the rejection of claims 13-20 be withdrawn for at least the same reasons as those presented above in connection with claim 12.

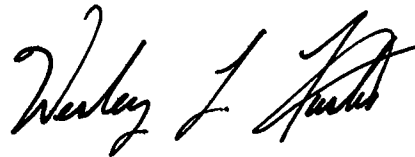
Claim 21 has been amended in a similar manner as claim 1. As such, Applicants submit that claim 21 is patentably distinct over Lopez. Accordingly, Applicants respectfully submit that the rejection of claim 21 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claims 22-29 depend either directly or indirectly from claim 21. Accordingly, Applicants respectfully request that the rejection of claims 22-29 be withdrawn for at least the same reasons as those presented above in connection with claim 21.

III. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin". The signature is fluid and cursive, with the first name "Wesley" being the most prominent.

/Wesley L. Austin/

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